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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,143	10/14/2003	Jay S. Walker	02-040	4772
22927	7590	01/21/2005	EXAMINER	
WALKER DIGITAL FIVE HIGH RIDGE PARK STAMFORD, CT 06905			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/685,143

**Applicant(s)**

WALKER ET AL.

**Examiner**

Scott E. Jones

**Art Unit**

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,21-26,35-40,55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,21-26,36-40,55 and 56 is/are allowed.
- 6) ☒ Claim(s) 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09022004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on October 29, 2004 in which applicant amends the specification, amends claims 1 and 21, cancels claims 7-20, 27-34, and 41-54, adds claim 56 and responds to the claim rejections. Claims 1-6, 21-26, 35-40, and 55-56 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 35 is rejected under 35 U.S.C. 102(e) as being anticipated by Beaulieu et al. (U.S. Pub. No. 2003/0064782).

Beaulieu et al. discloses a gaming device displaying an animated message adjacent to a game functional element such as a set of reels, set of cards, or a keno board. The game functional element can be shown on a video monitor screen. In one embodiment, a game title is displayed above the game functional element. Once the game functional element is put into play, an animated message appears to cover the game title. The animated message appears to enter the screen from behind the game functional element. Once the game functional element is

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no longer in play, the animated message appears to leave the screen by descending behind the game functional element. Beaulieu et al. additionally discloses :

Regarding Claim 35:

- determining a message (Abstract, Figures 4-15, Paragraphs 5,8-10, 50, 52-54, 60, and Claims 1-24);
- determining a representation of the message (Abstract, Figures 4-15, Paragraphs 5,8-10, 50, 52-54, 60, and Claims 1-24); and
- outputting the representation of the message to a player at a game machine, wherein determining a representation includes selecting a representation from a plurality of representations (Abstract, Figures 4-15, Paragraphs 5,8-10, 50, 52-54, 60, and Claims 1-24).

***Allowable Subject Matter***

4. Claims 1-6, 21-26, 36-40, and 55-56 seem to be allowable over the prior art of record.

***Response to Arguments***

5. Applicant's arguments with respect to the rejection to claim 35 under 35 U.S.C. 102(e) as being anticipated by Beaulieu et al. (U.S. Pub. No. 2003/0064782) has been considered but is persuasive.

Applicant alleges Beaulieu does not disclose all of the elements of any single claim and therefore a prima facie case of anticipation has allegedly not been established. In particular, Applicant alleges Beaulieu does not disclose or enable "selecting a representation from a plurality of representations." The examiner respectfully disagrees. Beaulieu discloses and enables a gaming device having a plurality of animated messages, one of said plurality of said

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animated messages being randomly selected by the processor and displayed on the display device when the functional element is put into play (Claim 9 and paragraph 51) (Emphasis Added). Therefore, the examiner maintains Beaulieu anticipates claim 35.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones  
Examiner  
Art Unit 3713



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